

REMARKS

Undersigned counsel for Applicant gratefully acknowledges the interview of February 14, 1997, with S.P.E. Zele in the continuing application filed February 12, 1997.

As pointed out at the interview, associate counsel newly assigned to the case believes that the Examiner's point is well taken that the terms to identify the parties to the calls were not consistently used in the specification and claims as originally filed. To make the application cleaner, the three parties involved have been consistently identified as the "calling party" who calls the telephone system, the "subscriber" whose identity is on file with the system, and the "third party" who is being called. The words "originator," "originating caller," "call originating station," etc. have all been deleted in favor of these three terms consistently used.

Also discussed at the interview was the substitution of claims 18 - 20 for claims 14 - 17, which have been canceled. The new claims are somewhat simpler method claims.

The parent case, now on appeal, had a Rule 131 declaration that was not specific in complying with MPEP 715.07. A draft Rule 131 declaration was presented at the interview and discussed. The Examiner pointed out the even the new draft failed to specifically recite the records of the inventor prior to the date of references relied upon in rejecting the claims of the parent case. The records of the inventor bearing dates before the cited prior art now are compared in the attached Declaration of Alleman specifically to the elements of the claims 1 - 9.

It was also pointed out at the interview that there was no evidence to support the assertion by Examiner Matar that the device described in the article dated September 12, 1992, was in existence on March 12, 1990. Examiner Matar read the statement in the article to the effect that the company referred to was in business for two and a half years as constituting proof that the machine that existed by 1992 must have existed on March 12, 1990. There is no evidence to support that leap. On the contrary, it is common experience that a company set up to build a machine usually does not have the machine in existence when it starts. In any event, the earliest date of any prior art relied upon by the Examiner is December 12, 1991, and the Declaration of Alleman clearly establishes the invention was completed before that date.

Also discussed at the interview was the reference to an article in the *New York Times* at page 4 of the Specification. In a draft of this preliminary amendment, undersigned counsel proposed to delete reference to the article, but Examiner Zele was concerned that it might constitute new matter to delete the reference.

Because *The New York Times* article was before the filing date of the original application of April 24, 1992, it is clearly prior art. However, the Declaration of Alleman proves that the invention was made before the prior art article, so it cannot be relied upon as a reference for rejecting the claims, or as an admission that the article antedates the invention.

As to the merits of the rejections made in the Final Rejection of the parent application, applicant submits the following remarks:

New drawings for Fig. 3, Fig. 4 and Fig. 5 have been submitted. The Claims have been amended by rewriting Claims 1-11 and 13, canceling Claims 14-17, and submitting new Claims 18-20. Claims 1-16 and 18-20 remain in the application, and Claims 14-17 stand withdrawn from consideration. A Declaration under 37 CFR §1.131 by the inventor, James H. Alleman is also submitted herewith.

The Specification and Claims 1-11 and 13, have been extensively amended to clarify the parties utilizing the system and the corresponding actions. Specifically:

- 1) "Calling Party" is the person calling the system to actuate a return call to the subscriber.
- 2) "Subscriber" is the person authorized to use the system to make a call to a third party. The system will telephone the subscriber when the subscriber's assigned telephone number is dialed by a calling party.
- 3) "Third Party" is the person whom the subscriber intends to call, using the system to make a connection from the system to the subscriber, and then a connection from the system to the third party. Thus, the subscriber is able to take advantage of the lower rate of the total for the two phone calls from the United States, instead of the direct rate from the subscriber to the subscriber to the third party.

A new Drawing for Fig. 3 is submitted herewith showing under what condition the process would proceed from 48 to 49.

New Drawings for Fig. 4 and Fig. 5 are submitted herewith replacing "called party" with "third party."

The Rejection Under 35 USC §112 is Overcome

The Examiner rejected independent Claims of the parent application under 35 U.S.C. §112, second paragraph, for failing to clearly identify that the system stores subscriber information instead of caller information. The Examiner further rejected the claims under Section 112 because it was not clear what "connecting to the subscriber telephone station" meant.

The Examiner's objections generally relate to the confusing language used in the parent application in regards to the party calling the system, the subscriber using the system, and the third party called from the system. The changing use of connecting parties and connecting parties' stations was also found confusing by the Examiner.

As amended, the Specification and Claims contain clear reference to the parties in relation to the system and what actions by those parties affect the system. Specifically, the party calling the system to actuate the call-back is the "calling party." This party was previously referred to as calling party station, caller, subscriber, originator, and originating station.

The person who is assigned a telephone number on the system to be called back by the system is the "subscriber." This party was previously referred to as calling party, calling party station, originator and originating party station.

The person who the subscriber intends to call using the telephone system is the "third party." This was previously called the "called party". However, "called party" is

ambiguous because the system calls both the subscriber and the third party. Therefore, as both parties could be seen as a "called party," the term "third party" is used to distinguish the party the subscriber calls using the system.

The consistent usage of these terms throughout the Specification is enabling to one skilled in the art to make the present invention and practice its method. Thus, in light of the above amendments, the rejection under 35 USC §112 is overcome.

The Rejections Under 35 USC §102 are Overcome

The Examiner had rejected the Claims of the parent application under Section 102(a) as being anticipated by the IDT machine disclosed in Business Week articles, the earliest of which is December 2, 1991, and said to have been admitted by the applicant as prior art in the parent application. The Examiner stated that the IDT machine described a "call-back" machine sufficiently to enable one skilled in the art to make the present invention. While the Examiner did admit that the articles did not teach the specific components of the IDT machine, the Examiner stated that the components would be "inherent" in the IDT machine.

The Examiner also rejected the Claims of the parent application under Section 102(b), holding that the IDT article was a statutory bar to patenting the present invention. The Examiner relied upon a statement in the article in *The Economist*, dated September 12, 1992, which stated that International Discount Telecommunications (IDT) was 2 1/2 years

old at that time. The Examiner relies upon this statement to claim that the IDT call-back machine was in use in the United States March 12, 1990. No evidence supports that date.

The claims of the present invention are allowable because: (1) the Declaration of Alleman

pursuant to 37 CFR §1.131, submitted herewith, antedates the earliest of the articles; (2) the admission of prior art in the present application has been removed as it is also antedated; and (3) the statement in an article dated September 12, 1992, that IDT was in business for 2 1/2 years cannot be a statutory bar under Section 102(b).

The Declaration of Alleman shows that the inventor conceived of the invention prior to December 2, 1991. The Declaration shows that the present invention was made before June 27, 1990.

Because of the earlier date of invention, the articles dated December 2, 1991, January 9, 1992, April 13, 1992, September 12, 1992, must be removed as references. *In re Stempel*, 241 F. 2d. 755, 113 USPQ 77 (CCPA 1957).

The Economist article dated September 12, 1992, stating that IDT was in business for 2 1/2 years, cannot be a statutory bar under Section 102(b). The article does not state that the IDT call-back machine was in use 2 1/2 years prior. The article only states that the company was "2 1/2 years old" as of September 12, 1992, and does not state what business IDT was in 2 1/2 years prior. The article does not establish a specific date when IDT used its call-back machine, and cannot be relied upon to establish a statutory bar to patenting under Section 102(b). The articles disclosing the IDT machines are overcome by

the Declaration of Alleman, and the references to the IDT machine must be removed from consideration. Therefore, all grounds of rejection under Section 102 are overcome and the claims are allowable.

The Rejection under 35 USC §103 is Overcome

The Examiner rejected the Claims of the parent application under 35 USC §103 as being obvious in light of the IDT machine disclosed in the articles, and in further view of U.S. Patent No. 4,086,438 to Kahn, et al., in view of U.S. Patent No. 4,769,834 to Billinger and U.S. Patent No. 5,185,782 to Srinivasan. The Examiner states that it would have been obvious to modify the IDT machine to use assigned telephone numbers of subscriber based upon DID signals for the calling parties to dial. Because the Declaration of Alleman removes the teaching references of the articles disclosing the IDT call-back machine, the rejection under Section 103 is overcome. Kahn in view of Billinger and Srinivasan does not teach a call-back system as claimed in the present invention. Accordingly, as the teaching references have been removed, the rejection under Section 103 has been overcome and the claims are allowable.

Conclusion

In view of the above, it is respectfully submitted that the claims are in condition for allowance. Reconsideration and withdrawal of the earlier rejections in the parent

application is requested and allowance of Claims 1-13 and 18-20 at an early date is solicited.

Respectfully submitted,

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